UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,037	06/06/2000	David S. Litman	068068.0103	9664

7590 01/13/2003

Baker Botts L.L.P.
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER	
DIXON, THOMAS A	
ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/589,037	LITMAN ET AL.	
	Examiner	Art Unit	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/6/2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claims 1, 12, 23 are directed to a system and method for making hotel reservations which is not seen to apply, involve, use or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the recitation of databases is seen to be merely multiple lists and not necessarily a technological element and will be given no weight.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

In the present case, making hotel reservations is seen to be useful and tangible for one who wishes to sleep indoors in a locality in which one does not have a home.

2. Claims 32-38, 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claim 32 are directed to method for matching an item to a request which is not seen to apply, involve, use or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the recitation of databases is seen to be merely multiple lists and not necessarily a technological element and will be given no weight.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

In the present case, making a request and matching that request is not seen to be useful, no specific utility is seen in the claimed invention, tangible or concrete due to the indefiniteness of the language, no repeatability or real effect is seen in the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "an item associated with a generic item" is seen to be indefinite, it is unclear what the metes and bounds of this claim are, this claim is made more indefinite in claim 33 by the phrase "wherein the generic item does not directly identify the item".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 1-3, 6-7, 11-14, 17-18, 23-25, 28, 32-34, 37, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (5,732,398) in view of Priceline.

As per Claim 1, 12, 23, 32.
Tagawa discloses:
a hotel/item master database operable to store information associated with one or more hotels/items, see figure 5a (308);
an inventory database operable to store room/item availablity on one or more dates and price data, see figure 2c (124);
a reservation engine, see figure 2c (138):
receive hotel/item availability request, see figure 5a (304);
access the hotel/item master database and the inventory database to obtain information associated with the request, see
determine one or more hotels/items that meet the parameters in response to obtaining the information from the hotel master database and the inventory database, see column 12, lines 45-59;
communicate a list of the hotels/items meeting the parameters of the request, see figure 5a (308);
receive a request for a hotel reservation/item, see figure 5b (314) and column 13, lines 18-25;
create a reservation/request according to the request, see figure 5b (318) and column 13, lines 18-25.
Tagawa further discloses allowing for selecting hotels/items by type (budget, mid-range, and deluxe) that is seen to be offer generic lodgings, but does not specifically disclose that the list includes a generic hotel/item.

The presence of a generic hotel on the list is seen as non-functional descriptive material not bearing any patentable weight. This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed, Cir. 1983).

Priceline teaches anonymously offering lodgings/items at a discount for the benefit of giving anonymity to the provider so as not to diminish the trademark/reputation of the hotel, yet maximize bookings.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide a generic list of available rooms/items in the invention of Tagawa as taught by Priceline for the benefit of giving the provider so as not to diminish the trademark/reputation of the hotel, yet maximize bookings/sales.

As per Claim 2, 13, 24, 33.

Tagawa further discloses receive a request for a description of a generic hotel/item and communicate a description of the hotel/item, see figure 5a (310, 312).

As per Claim 3, 14, 25, 34.

Tagawa further discloses communicating a specific description of the hotel at which a reservation has been created, see figure 5b (322).

As per Claim 6, 17, 28, 37.

Tagawa does not specifically disclose a discounted price.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed, Cir. 1983).

Priceline teaches anonymously offering lodgings at a discount for the benefit of giving anonymity to the provider so as not to diminish the trademark/reputation of the hotel, yet maximize bookings.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide a discount lodgings in the invention of Tagawa as taught by Priceline for the benefit of giving the provider so as not to diminish the trademark/reputation of the hotel, yet maximize bookings.

As per Claim 7, 18.

Tagawa further discloses availability data, see figure 5a (304).

As per Claim 11, 22, 40.

Tagawa further discloses:

the reservation engine is coupled to a call center, the call center coupled to a telephone network and operable to receive calls from telephone users, see column 13, lines 2-10, column 16, lines 46-54, column 17, lines 21-25 and figure 1 (34);

the reservation engine further operable to receive hotel availability request, see figure 5a (304);

communicate the list of hotels, see figure 5a (308).

5. Claims 4-5, 8-9, 15-16, 19-20, 26-27, 29, 35-36, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (5,732,398) in view of Priceline further in view of Schneider et al (5,832,452).

As per Claim 4, 15, 26, 35, 38.

Tagawa does not specifically disclose that the data includes the name and a description of a hotel/item.

The presence of a generic hotel/item on the list is seen as non-functional descriptive material not bearing any patentable weight. This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed, Cir. 1983).

Schneider et al teaches a hotel/item name and description, see figure 7 for the benefit of providing users with data regarding a hotel to assist in making a decision regarding lodgings.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a details listing as taught by Schneider et al in the invention of Tagawa for the benefit of providing users with data regarding a hotel/item to assist in making a decision regarding lodgings/purchases.

As per Claim 5, 16, 27, 36.

Tagawa does not specifically disclose that the data includes the name and a description of a hotel/item.

Schneider et al teaches a hotel/item name and description, see figure 7 for the benefit of providing users with data regarding a hotel to assist in making a decision regarding lodgings.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a details listing as taught by Schneider et al in the invention of Tagawa for the benefit of providing users with data regarding a hotel/item to assist in making a decision regarding lodgings/purchases.

As per Claim 8, 19, 29.

Tagawa does not specifically disclose that the data includes the price of the room/item.

The presence of a generic hotel/item on the list is seen as non-functional descriptive material not bearing any patentable weight. This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed, Cir. 1983).

Schneider et al teaches providing the price of a hotel room/item, see figure 7 (72a) for the benefit of providing users with data regarding a hotel/item to assist in making a decision regarding lodgings/purchases.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a details listing as taught by Schneider et al in the invention of Tagawa for the benefit of providing users with data regarding a hotel to assist in making a decision regarding lodgings.

As per Claim 9, 20.

Tagawa does not specifically disclose that the data includes the location of the hotel.

The presence of a generic hotel on the list is seen as non-functional descriptive material not bearing any patentable weight. This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed, Cir. 1983).

Schneider et al teaches providing the location of a hotel, see figure 7 (72a) for the benefit of providing users with data regarding a hotel to assist in making a decision regarding lodgings.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a details listing as taught by Schneider et al in the invention of Tagawa for the benefit of providing users with data regarding a hotel to assist in making a decision regarding lodgings.

6. Claims 10, 21, 30, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (5,732,398) in view of Priceline further in view of Isaacson et al (WO 00/19351).

As per Claim 10, 21, 30, 39.

Tagawa further discloses the internet, see column 9, lines 60-65.

Tagawa does not specifically disclose the list of communicated as one or more web pages.

Isaacson et al teaches accessing the travel system on the internet using a web browser, see page 10, lines 21-29 and figures 25, 27 and 28 for the benefit of using well known web based protocols.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to communicate the list of hotels of Tagawa using web pages as taught by Isaacson et al for the benefit of using well known web based protocols.

Prior Art Made of Record

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,404,877 to Bolduc et al teaches a call center for accepting voice calls, internet or email.

WO 00/19351 to Isaacson et al is the closest foreign art teaches a request for generic lodging or flights without a preference for provider.

Priceline is the closest non-patent literature which teaches making request for a generic hotel room of a given quality, but does not teach a listing of hotels.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Thomas A. Dixon
Examiner
Art Unit 3629

January 9, 2003